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David J Gaskey
Carlson Gaskey & Olds
Suite 350
400 W Maple Road
Birmingham, MI 48009

EXAMINER

KRUER, STEFAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN T. McNAMARA
and ALFRED R. FEITL

Appeal 2009-009503
Application 10/556,801
Technology Center 3600

Before WILLIAM F. PATE, III, STEVEN D.A. McCARTHY, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown in the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Brian T. McNamara and Alfred R. Feitl (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting:

(1) claim 6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 3);

(2) claims 1, 7-9, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over Fuller (U.S. Patent No. 5,750,945, issued May 12, 1998) and Miyoshi (United Kingdom Patent Application Publication No. GB 2 270 292 A, published Sep. 03, 1994) (Ans. 4);

(3) claims 2, 10, and 12-14 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, and Ach (U.S. Patent Application Publication No. 2001/0025743 A1, published Oct. 4, 2001) (Ans. 7);

(4) claims 3-6 and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, Ach, and Baranda (U.S. Patent No. 6,401,871 B2, issued Jun. 11, 2002) (Ans. 8); and

(5) claims 20-23 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Baranda (Ans. 10).

Appellants cancelled claim 11. We have jurisdiction under 35 U.S.C. § 6(b).
We REVERSE.

The Invention

The claims on appeal relate to an elevator system and to an assembly for providing tension on a load bearing member in an elevator system.

Claims 1 and 20, reproduced below with emphasis added, are illustrative of the subject matter on appeal.

1. An elevator system, comprising:
a cab;
a counterweight;
a load bearing member extending between the cab and the counterweight so that the cab and counterweight move simultaneously;
a tension member extending between the cab and the counterweight, the tension member providing a desired tension on the load bearing member;
a termination associated with an end of the tension member, the termination including an elastic element that dampens an initial tendency of the cab or the counterweight to continue moving even though the other of the cab or the counterweight has stopped; and
a damper supported for movement with one of the cab or the counterweight, the one end of the tension member being associated with the damper such that the damper reduces motion of the cab or the counterweight when the other of the cab or the counterweight has stopped after a bias of the elastic element is overcome and the elastic element is at least partially compressed.

20. An elevator system, comprising:
a cab;
a counterweight;
a load bearing member extending between the cab and the counterweight so that the cab and counterweight move simultaneously;
a tension member extending between the cab and the counterweight, the tension member providing a desired tension on the load bearing member, the tension member comprising a plurality of belts each having a thickness of approximately 10 mm and a width of approximately 30 mm; and

a damper supported for movement with one of the cab or the counterweight, one end of the tension member being associated with the damper such that the damper reduces motion of the cab or the counterweight when the other of the cab or the counterweight has stopped.

OPINION

Issues

The determinative issues in this appeal are:

(1) Did the Examiner err in determining that originally filed claim 6 fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph?

(2) Did the Examiner err in interpreting Fuller to have “a damper supported for movement with one of the cab or counterweight, the one end of the tension member being associated with the damper such that the damper reduces motion of the cab or the counterweight when the other of the cab or the counterweight has stopped after a bias of the elastic element is overcome and the elastic element is at least partially compressed” (App. Br. 15, claim 1 and App. Br. 17, claim 10)?

(3) Did the Examiner err in interpreting Baranda to disclose “a tension member extending between the cab and the counterweight, the tension member comprising a plurality of belts” (App. Br. 19, claim 20)?

Analysis

Issue 1

Appellants contend that since claim 6 is an originally filed claim, the Examiner erred in rejecting claim 6 for containing subject matter that was not described in the specification in such a way as to reasonably convey to

one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. App. Br. 7-8. Appellants also contend that the specification, at page 4, lines 8-13, provides support for the subject matter of claim 6 because “[t]hat portion of the specification clearly describes an example belt having characteristics consistent with those recited in claim 6” and that the drawing show a plurality of belts. App. Br. 8. Appellants also contend that a person of ordinary skill in the art would understand that what is recited in claim 6 was disclosed in a manner consistent with the requirements of 35 U.S.C. § 112, first paragraph, and that no further details are required in the description or drawings to convey to a person of ordinary skill in the art the subject matter of claim 6. *Id.*

The Examiner’s position is that claim 6 fails to comply with the written description requirement under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Ans. 3. More particularly, the Examiner posits that:

[t]he claim recites a tension member comprising a plurality of belts wherein each belt has a thickness of approximately 10 mm and a width of approximately 30 mm as well as the possibility of having multiple belts of unspecified dimensions (as derived from "In one example...", Specification, Page 4, L. 8). Furthermore, the disclosure states that the inventive belt is "... significantly different than a rope or chain used in "conventional compensating arrangements"; however, said belt is not properly depicted.

Ans. 3.

The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the applicant was in possession of the invention as now claimed. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560-64 (Fed. Cir. 1991). The possession test alone, however, is not always sufficient to meet the written description requirement. *See Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). Rather, “the written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Id.* (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). The written description requirement is not necessarily met as a matter of law because the claim language appears *in ipsius verbis* in the specification. *See Enzo*, 323 F.3d at 968. “The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy [the written description] requirement.” *Id.* “The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.” *Id.*

We agree with Appellants that claim 6, as an originally filed claim, is part of the original disclosure. The Examiner appears to be concerned that the Specification, at page 4, line 9, discloses an example of a belt with a 9.4 mm thickness while claim 6 recites a plurality of belts each having an approximately 10 mm thickness which is not supported in the specification. However, the Examiner is confusing the written description requirement under 35 U.S.C. § 112, first paragraph, with the requirement under 37 C.F.R. § 1.75(d)(1) that “claims must find clear support or antecedent basis in the

description so that the meaning of the terms in the claims may be ascertainable by reference to the description.”

In view of the foregoing, we do not sustain the Examiner’s rejection of claim 6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Issue 2

Appellants contend that the Examiner has failed to set forth a prima facie case of obviousness with respect to claims 1-10 and 12-17 because there is no damper in Fuller that is “supported for movement with one of the cab or counterweight, the one end of the tension member associated with the damper such that the damper reduces motion of the cab or the counterweight when the other of the cab or counterweight has stopped after a bias of the elastic element is overcome and the elastic element is at least partially compressed” (App. Br. 15, claim 1 and App. Br. 17, claim 10). App. Br. 8-9. Appellants also contend that the active force actuators 56 of Fuller are not associated with an end of a tension member 16. App. Br. 9. Appellants also contend that Fuller’s active force actuators 56 do not perform the function suggested by the Examiner as can be seen from Fuller’s column 7, lines 10-23, which discloses that when the brakes are applied to stop the elevator car 12, the hitch command signal is controlled to freeze the position of the force actuators 56. *Id.* In other words, Appellants contend that the active force actuators 56 are locked in position when the elevator car brakes are applied and no damping occurs that reduces motion after a bias of the elastic element is overcome as required by the claims. *Id.* Appellants also contend that the Examiner’s reference to the last sentence of Fuller’s Abstract in the Advisory Action mailed August 7, 2008 reinforces Appellants’ position that

the active force actuators 56 are applicable to the elevator cab in motion because the sentence states “*along the elevator flight path*” and this is the opposite of an elevator cab that has stopped as is being recited in the claims. *Id.* Appellants also contend that “it is not possible to use the *Miyoshi* reference to somehow change how the *Fuller et al.* arrangement is described as working” because modifying Fuller by Miyoshi would change the principle of operation of Fuller and because Miyoshi operates in a manner directly opposite of the claimed invention. App. Br. 10. More particularly, Appellants contend that the claims recite that a bias of an elastic element of a termination must be overcome first before a damper associated with a tension member acts meaning that the spring constant or elastic coefficient of the damper is higher than that of the elastic element, but Miyoshi’s elastic element between the counterweights is composed of a member having an elastic coefficient smaller than that of the ropes and thimble rod spring. *Id.* Appellants also contend that the “*Ach* reference does nothing to remedy the defect in the Examiner’s improper, proposed combination of the *Fuller, et al.* and *Miyoshi, et al.* references.” App. Br. 11.

The Examiner’s position is that Fuller discloses the invention substantially as claimed, except that Fuller fails to disclose that the termination is “associated with an end of the tension member” (App. Br. 15, 17, and 18). Ans. 4 and 6. The Examiner posits that Miyoshi discloses terminations (4, Figure 8) associated with both the load bearing member (3) and the tension member (11) “to afford vibration damping of both the load bearing and tension members in anticipation of mechanically generated vibrations as known in the art ([p]age 2, [line] 15).” Ans. 5 and 6. The Examiner concludes that it would have been obvious to one of ordinary skill

in the art to modify Fuller by Miyoshi “for driving control” and cites to Miyoshi, page 2, line 27. *Id.*

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445; *see also Piasecki*, 745 F.2d at 1472.

Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

We agree with Appellants that the Examiner has failed to set forth a prima facie case of obviousness. The Examiner has not established by a preponderance of the evidence that Fuller’s active force actuators 56 satisfy the claim limitations of being a damper that “reduces motion of the cab or the counterweight when the other of the cab or the counterweight has stopped after a bias of the elastic element is overcome and the elastic element is at least partially compressed” (App. Br. 15, claim 1 and App. Br. 17, claim 10). Although the Examiner is charged with giving claim terms their broadest reasonable interpretation consistent with the specification (*See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997)), the Examiner erred in interpreting the claim language of “a damper . . . such that the damper reduces motion of the cab or counterweight when the other of the cab or the counterweight has stopped after a bias of the elastic element is overcome” to include the active force actuators 56 of Fuller because of what Fuller discloses at column 7, lines 10-23.

Moreover, the key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). *See also KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). Here, the Examiner has failed to articulate a sufficient reason with some rational underpinning as to why the teachings of Fuller and Miyoshi would have been obvious to a person having ordinary skill in the art. Indeed, the Examiner’s reasoning of “for driving control” appears to be a mere conclusory statement rather than a clear articulation of a reason with some rational underpinning as to why a person of ordinary skill in the art would modify Fuller to move the active hitch assembly 36 from being attached to an end of the main rope or load bearing member 14 to being attached to an end of the compensation rope or tension member 16.

In view of the foregoing, we do not sustain the Examiner’s rejection of claims 1, 7-9, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over Fuller and Miyoshi, and the Examiner’s rejection of claims 2, 10, and 12-14 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, and Ach. We also do not sustain the Examiner’s rejection of claims 3-6 and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, Ach, and Baranda since it is based upon the same erroneous interpretation of the active force actuators 56.

Issue 3

Appellants contend that the Examiner's rejection of claims 20-23 based upon the combination of Miyoshi and Baranda fails to set forth a prima facie case of obviousness because Baranda "discloses a belt corresponding to the *load bearing member* of Appellants' claim 20" and "[t]here is nothing in the Miyoshi, et al. or Baranda, et al. references that discloses or in any way suggests using a plurality of belts as the *tension member* recited in Appellants' claim 20." App. Br. 12. Appellants also contend that Baranda's sheaves are traction sheaves used to direct the load bearing member and having nothing to do with the tension member as recited in Appellants' claims so that even if the Miyoshi and Baranda references are combinable, the result is not what the Examiner has suggested and there is no prima facie case of obviousness. *Id.* Appellants also contend that there is no disclosure in Baranda that a load bearing member can be alternatively utilized as a tension member as suggested by the Examiner on page 15 of the Examiner's Answer because tension member as used in Appellants' claims has a particular meaning. Reply Br. 2.

The Examiner's position is Miyoshi discloses the invention substantially as claimed in claim 20, except that Miyoshi fails to explicitly disclose the tension member comprising a belt. Ans. 10. The Examiner posits that Baranda discloses a tension member comprising a plurality of belts in Figure 3. *Id.* The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Miyoshi by the teachings of Baranda "for savings in capital- and operating costs." Ans. 11. The Examiner further concludes that:

. . . , it would have been an obvious to one of ordinary skill in the art, as a matter of optimization and experimentation, to provide the belts having a thickness of *approximately* 10 mm and a width of *approximately* 30 mm in as much as the criticality of these dimensions has not been disclosed yet such constructions have been anticipated by the prior art of record as reviewed above.

Id.

We agree with Appellants that tension member 22 of Baranda corresponds to the load bearing member 30 extending from the top of the elevator cab 22 to the top of the counterweights 26 of the present invention, not the tension member 42 extending from the bottom of the elevator cab 22 to the bottom of the counterweights 26 of the present invention. The Examiner has erred in interpreting that Baranda discloses a tension member comprising a plurality of belts. Rather, Baranda discloses a load bearing member (i.e., tension member 22) comprising a plurality of belts. There is no disclosure in Baranda that the tension member 22 can be used from the bottom of the elevator car 14 to the top of the counterweights 16 so as to correspond to the tension member 42 of the present invention.

In view of the foregoing, we do not sustain the Examiner's rejection of claims 20-23 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Baranda.

CONCLUSIONS

The Examiner erred in determining that originally filed claim 6 fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

The Examiner erred in interpreting Fuller to have “a damper supported for movement with one of the cab or counterweight, the one end of the tension member being associated with the damper such that the damper reduces motion of the cab or the counterweight when the other of the cab or the counterweight has stopped after a bias of the elastic element is overcome and the elastic element is at least partially compressed (App. Br. 15, claim 1 and App. Br. 17, claim 10).

The Examiner erred in interpreting Baranda to disclose “a tension member extending between the cab and the counterweight, the tension member comprising a plurality of belts.”

DECISION

We reverse the Examiner’s rejection of: claim 6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1, 7-9, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over Fuller and Miyoshi; claims 2, 10, and 12-14 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, and Ach; claims 3-6 and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Fuller, Miyoshi, Ach, and Baranda; and claims 20-23 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Baranda.

REVERSED

Klh

DAVID J. GASKEY
CARLSON, GASKEY & OLDS
SUITE 350
400 W. MAPLE ROAD
BIRMINGHAM, MI 48009